

REMARKS

I. INTRODUCTION

Claims 1, 60 and 64 have been amended. New claims 68 and 69 have been added. Claims 3-55 were previously cancelled, without prejudice. Accordingly, claims 1, 2 and 56-69 are now under consideration in the present application. Provided above, please find a claim listing indicating the claim amendments, claim additions and current status of the claims on separate sheets so as to comply with the requirements set forth in 37 C.F.R. § 1.121. It is respectfully submitted that no new matter has been added.

II. REJECTION UNDER 35 U.S.C. § 112 SHOULD BE WITHDRAWN

Claim 60 stands rejected under 35 U.S.C. § 112, second paragraph, as being allegedly indefinite. Specifically, the Examiner alleges that the distal portion is curved, thus presenting multiple angles, and that an acute angle is not disclosed in the specification, and the drawings only shown a 90 degree angle.

Although Applicants respectfully disagree, claim 60 has been amended to recite that the distal end of the wire comprises a hook-shaped portion. Support for the amendment is found in the drawings and Specification. (See, e.g., Figs. 4a, 4b and para. [0037]).

Accordingly, Applicants respectfully request that the 35 U.S.C. § 112, second paragraph, rejection of claim 60 be withdrawn.

III. REJECTION UNDER 35 U.S.C. §§ 102/103(a) SHOULD BE WITHDRAWN

Claims 1, 56, 57 and 62-65 stand rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by U.S. Patent No. 5,558,644 to Boyd et al. (hereinafter “Boyd”). Claims 2 and 66 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Boyd. Claims 58-61 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Boyd, in view of U.S. Patent No. 6,629,534 to St. Goar et al. (hereinafter “St. Goar”). Claim 67 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Boyd, in view of U.S. Patent No. 6,283,127 to Sterman et al. (hereinafter “Sterman”).

Applicants respectfully assert that Boyd, taken individually or in combination with Goar and/or Sterman, does not disclose, teach or suggest the subject matter recited in amended independent claim 1 for at least the reasons provided herein below.

In order for a claim to be rejected as anticipated under 35 U.S.C. § 102, each and every element as set forth in the claim must be found, either expressly or inherently described, in a single prior art reference. Manual of Patent Examining Procedures, §2131; *also see Lindeman Maschinenfabrik v. Am Hoist and Derrick*, 730 F.2d 1452, 1458 (Fed. Cir. 1984).

“To reject claims in an application under Section 103, an examiner must show an un rebutted *prima facie* case of obviousness.” *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998). The Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966), stated:

Under Section 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the

pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined.

Indeed, to sustain a rejection under 35 U.S.C. § 103(a), there must be some teaching, other than the instant application, to alter the prior art to arrive at the claimed invention.

“The problem confronted by the inventor must be considered in determining whether it would have been obvious to combine the references in order to solve the problem.”

Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 679 (Fed. Cir. 1998).

The objective standard for determining obviousness under 35 U.S.C. § 103, as set forth in *Graham v. John Deere, Co.*, 383 U.S. 1 (1966), requires a factual determination to ascertain: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; and (3) the differences between the claimed subject matter and the prior art. Based on these factual inquiries, it must then be determined, as a matter of law, whether or not the claimed subject matter as a whole would have been obvious to one of ordinary skill in the art at the time the alleged invention was made. *Graham*, 383 U.S. at 17. Courts have held that there must be some suggestion, motivation or teaching of the desirability of making the combination claimed by the applicant (the “TSM test”). See *In re Beattie*, 974 F.2d 1309, 1311-12 (Fed. Cir. 1992). This suggestion or motivation may be derived from the prior art itself, including references or disclosures that are known to be of special interest or importance in the field, or from the nature of the problem to be solved. *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573 (Fed. Cir. 1996).

Although the Supreme Court criticized the Federal Circuit’s application of the TSM test, see *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, (2007) the Court also indicated that the TSM test is not inconsistent with the *Graham* analysis

recited in the *Graham v. John Deere* decision. *Id.*; see *In re Translogic Technology, Inc.*, No. 2006-1192, 2007 U.S. App. LEXIS 23969, *21 (October 12, 2007). Further, the Court underscored that “it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *KSR*, 127 S. Ct. at 1741. Under the precedent established in *KSR*, however, the presence or absence of a teaching, suggestion, or motivation to make the claimed invention is merely one factor that may be weighed during the obviousness determination. *Id.* Accordingly, the TSM test should be applied from the perspective of a person of ordinary skill in the art and not the patentee, but that person is creative and not an automaton, constrained by a rigid framework. *Id.* at 1742. However, “the reference[s] must be viewed without the benefit of hindsight afforded to the disclosure.” *In re Paulsen*, 30 F.3d 1475, 1482 (Fed. Cir. 1994).

The prior art cited in an obviousness determination should create a reasonable expectation, but not an absolute prediction, of success in producing the claimed invention. *In re O’Farrell*, 853 F.2d. 894, 903-04 (Fed. Cir. 1988). Both the suggestion and the expectation of success must be in the prior art, not in applicant’s disclosure. *Amgen, Inc. v. Chugai Pharmaceutical Co., Ltd.*, 927 F.2d 1200, 1207 (Fed. Cir. 1991) (citing *In re Dow Chem. Co.*, 837 F.2d 469, 473 (Fed. Cir. 1988)). Further, the implicit and inherent teachings of a prior art reference may be considered under a Section 103 analysis. See *In re Napier*, 55 F.3d 610, 613 (Fed. Cir. 1995).

Secondary considerations such as commercial success, long-felt but unsolved needs, failure of others, and unexpected results, if present, can also be considered. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538-39 (Fed. Cir. 1983). Although

these factors can be considered, they do not control the obviousness conclusion. *Newell Cos. v. Kenney Mfg. Co.*, 864 F.2d 757, 768 (Fed. Cir. 1988).

To establish obviousness, the prior art references must be evaluated as a whole for what they fairly teach and neither the references' general nor specific teachings may be ignored. *Application of Lundsford*, 357 F.2d. 385, 389-90 (CCPA 1966). A reference must be considered for all that it teaches, not just what purportedly points toward the invention but also that which teaches away from the invention. *Ashland Oil, Inc. v. Delta Resins & Refractories*, 776 F.2d. 281, 296 (Fed. Cir. 1985).

Amended independent claim 1 recites, *inter alia*, a cutting arrangement, a catheter, and a grasping arrangement, wherein the catheter comprises an opening in which the grasping arrangement constrains the movement of the chord and through which the cutting arrangement is provided to sever the at least one chord. For example, in Fig. 4A, in an exemplary embodiment of the present application, the catheter 20 comprises a notch 24 in which a wire 30 can constrain a movement of a chord 10, and in which the blade 28 can be provided to sever the chord 10.

However, the catheter described in Boyd does not disclose, teach or suggest a catheter comprising an opening in which the grasping arrangement constrains the movement of the chord and through which the cutting arrangement can be provided to sever the at least one chord, as recited in amended independent claim 1. Boyd, on the other hand, describes a catheter through which forceps 71 and blades 68, 69 are provided. The grasping and the cutting are performed outside any opening of the catheter. St. Goar and Sterman do not cure these deficiencies of Boyd, and the Examiner does not allege that they do.

Regarding the rejections of the dependent claims, Applicant respectfully asserts that Boyd, taken individually or in combination with St. Goar and/or Sterman, fails to disclose, teach or suggest the explicit recitations of amended independent claim 1. Accordingly, the claims which depend from amended independent claim 1 are also patentable over the references relied upon by the Examiner at least because these publications fail to disclose, teach or suggest the features of amended independent claim 1.

Further, amended claim 60 recites that a distal end of the wire comprises a hook-shaped portion. Boyd, St. Goar and Sterman, taken individually or in combination, do not disclose, teach or suggest a wire comprising a hook-shaped portion, as shown in an exemplary embodiment in Figs. 4A and 4B of the present application, and recited in amended claim 60.

Claim 62 recites, *inter alia*, that the grasping arrangement comprises a pincer member that is **rotatably coupled** to the catheter. Claim 63 recites, *inter alia*, that the grasping arrangement comprises two pincer members that are **rotatably coupled** to the catheter. The Examiner alleges that the blades 68 and 69 of Boyd in Fig. 5 thereof are arranged in a pincer configuration and as rotatable relative to the catheter. (See, Office Action dated December 31, 2008, p. 2, last paragraph). However, claims 62 and 63 recite that the pincer member(s) is rotatably **coupled** to the catheter. The blades 68, 69 of Boyd are not coupled to the catheter and are positioned with respect to the chord independently of the catheter. Therefore, claims 62 and 63 are patentable over Boyd. St. Goar and Sterman do not cure these deficiencies, and the Examiner does not allege that they do.

Amended claim 64 recites a stabilizing arrangement configured to at least partially constrain a motion of the catheter relative to a location within a chamber of a heart and extend longitudinally from the catheter to an apex of a ventricle. Boyd does not disclose a stabilizing arrangement configured to extend longitudinally from the catheter to an apex of a ventricle. St. Goar and Berman do not cure these deficiencies, and again, the Examiner does not allege that they do.

Therefore, for at least the reasons as presented herein above, Applicants respectfully request withdrawal of the 35 U.S.C. § 102(b) rejection of claims 1, 56, 57 and 62-65 as being allegedly anticipated by Boyd, the 35 U.S.C. § 103(a) rejection of claims 2 and 66 as allegedly being unpatentable over Boyd, the 35 U.S.C. § 103(a) rejection of claims 58-61 as allegedly being unpatentable over Boyd in view of St. Goar, and the 35 U.S.C. § 103(a) rejection of claim 67 as allegedly being unpatentable over Boyd in view of Sterman.

IV. NEW CLAIMS 68-69

New claims 68 and 69, which depend from independent claim 1, have been added above to cover certain exemplary embodiments of Applicants' invention. Support for these new claims can be found in the originally-filed specification and drawings. Applicants respectfully assert that new claims 68 and 69 are allowable over Boyd, St. Goar and Sterman, either taken alone or in combination. It is respectfully requested that a confirmation of patentability of these claims be provided in the next communication for this application to Applicants' representatives.

V. CONCLUSION

In light of the foregoing, Applicants respectfully submit that pending claims 1,2 and 56-69 are in condition for allowance. Prompt consideration, reconsideration and allowance of the present application are therefore earnestly solicited. If any issues remain outstanding, the Examiner is invited to contact the undersigned via the telephone number provided below.

Respectfully submitted,

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